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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,095	06/19/2001	Stephen Thomas Blocher	END920010013US1	2413
23550 7590 06/01/2007 HOFFMAN WARNICK & D'ALESSANDRO, LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207			EXAMINER BROOKS, MATTHEW L	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 06/01/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/884,095	BLOCHER ET AL.	
	Examiner	Art Unit	
	Matthew L. Brooks	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in follows the RCE made on 3/19/2007 and is in reply to the Remarks and Amendments made on 2/20/2007. Note at the beginning of the Remarks IV on pg 13 of 18 Applicant states in lines 3 and 4 that Applicant "... reserve the right to present specific arguments regarding any rejected claims not specifically addressed." This is not the case. Examiner points Applicant to MPEP 714.02 "Must Be Fully Responsive" and that the Applicant must reply to every ground of rejection.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "separate template" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claims 1-30** are rejected under 35 U.S.C. 103 (a) as being unpatentable over the public activities of Keane Inc. as of May 5th, 2000 as shown by their web Homepage

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as of said date and “PRAM it or walk away”; Gray, Neal; Transactions of AACE International; pp: r5-48; 1998. collectively one reference (PRAM)

5. With respect to **Claim 1 and 7, 8, 9 and 10**: PRAM discloses

A computer implemented method for reviewing a business process to identify and address risks, comprising the step of:

providing a business process {see whole document};

identifying risks in the business process as control points {see pg A, iv and v; and pg B, v as soon as the risks are identified and placed on a template they become control points; ie see D, figure 3; this is further supported by the definition of “control point as known in the art and Applicant’s definition found on pg 8, “Control Point” – a risk identified in a business process that should be addressed”}; and

arranging information pertaining to the control points (this is the equivalent to arranging information pertaining to the risks such as what they are and how to mitigate) in a standard format using a template and storing the template in a computer database to provide subsequent access to the template, wherein the information comprises a set of tests to be performed by a test entity, and wherein the set of tests identify an occurrence of the risks in the business process. {Pg A, PRAM C1, line 7 states the problem was “never written down” and Pg C, (v) 1 page for graphical visualization; and pg D, fig 3 Keane is a consultant/auditor/test entity which conducts tests and consults/audits companies risks and how to address them via an “e-solutions strategy”/action entity and thus implemented on a computer and audits using a template, inherently if made by computer and stored persons will have access; as to

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newly added matter "occurrence of the risk" See fig 3, given broadest reasonable interpretation of the claimed language, the fig shows a set of tests identifying an occurrence of risks in the business process; ie, Timely Acceptance Sign Off}.

PRAM arguably fails to teach that there is a separate template for each control point and rather has all of the control points on one template.

However when the prior art teaches all of the limitations except for making separable the steps or components the application's claims are held to be obvious. **Making Separable** In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify PRAM to make the separate templates for the control points because case law has held to do so is obvious.

Additionally, this is merely a matter of design choice of the template/s.

6. With respect to **Claim 2 and 9**: PRAM discloses identifying actions to address the risks {See fig. 3, 2 "Risk Mitigation Action"}; arranging the identified actions in the template {See fig 3, Risk Profile}; and

performing an audit using the template {see whole document, the reason why a user would create a "risk profile" is to perform and audit, this too is where the step of accessing the template occurs, see also pg B, v; "If there isn't a template, begin making one so that the next time you, or someone else, needs to identify risks you wont have to start from scratch" This is the same as storing a template in a data base to later use/access again.}.

7. With respect to **Claim 3**: PRAM discloses

step of identifying risks comprises the step of implementing a set of tests to identify risks in the business process {pg B, v and vi; "Identify Risks" and "Determine Probability and Consequence"}.

8. With respect to **Claim 4**: PRAM discloses

(NOTE: As for claim 4, the information on the template is considered to be non-functional descriptive data, see above)

a set of tests, wherein the set of tests identify risks in the business process {fig 3}; and

a set of actions, wherein the set of actions address the risks (fig 3).

9. With respect to **Claim 5**: PRAM discloses

(NOTE: As for claim 5, the information on the template is considered to be non-functional descriptive data, see above)

a business process {See PRAM};

a test entity, wherein the test entity performs the set of tests {See fig 3 and whole document};

an action entity, wherein the action entity performs the set of actions; and audit details {See fig 3 and whole document}.

10. With respect to **Claim 6**: PRAM discloses

(NOTE: As for claim 6, the information on the template is considered to be non-functional descriptive data, see above)

a control point name {pg D, fig 3};

control point revisions { pg D, fig 3};

background information { pg D, fig 3}; and

a control point frequency { pg D, fig 3}.

11. **Claims 10-29** (system, program, method, template) recite the same limitations already discussed above and are rejected on the same analysis.

12. Claims 27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over PRAM and the rejection above in further view of Official Notice.

Claims 1-30 are rejected under 35 U.S.C. 103 as being unpatentable over the PRAM reference. The PRAM reference discloses all of the limitations as discussed above; the method in which nearly all consultants analyzing risk normally use and steps and considerations made (ie; id risk, determine how to mitigate, and keep track on a template). PRAM does not discuss the use of the internet and an access field that includes a hypertext link that would allow direct access to a field as claimed. In determining the obviousness of applying what is generally known in the risk consulting industry to what is known in the world of the Internet one must determine the level of ordinary skill (*Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976)). The Internet, to

one ordinarily skilled in the art, for some time now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be for one computer to access and download files from another computer located at a different site than the first. Using a hypertext link to access such information is widely known by the use of html and linking techniques. Also, the risk consulting industry has utilized computers for years to keep track of accounts and present this data to their customers and employees through GUI's. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the Internet to access the data in one's template/risk profile in a typical risk analysis system such as that taught in the PRAM reference for the purpose of obtaining/editing information. The desirability to do this is clearly to save a customer/employee the time of having to work on paper and pull the template/risk profile each time a user would want to view and or edit the account information; reduce operational costs through more effective information delivery; and improve compliance checking capability.

Response to Arguments

13. Applicant's arguments filed 2/27/2007 have been fully considered but they are either moot or not persuasive.

14. In reply to: pg 17 Applicant has traversed Examiners Official Notice that of "inserting a hypertext link into a template to take a user to further information/a new web page" and asserts that it was not well known to one of ordinary skill. Official Notice is proper when it has instantly recallable/ searchable and/or unquestionable. In the present case Examiner went to proquest.com typed in "hypertext and template" before

Applicant filing date and instantly found the attached four references. For example in "Corel Corp.: WordPerfect Internet Publisher" it is taught WordPerfect is a template (pg 1) and that on tables/templates the program included the option to insert hypertext. Official Notice of the known fact is maintained.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- A. A printout of KEANE's homepage as pulled from the www.archive.org with a 102 (b) date showing Keane was up and running on the web "e-solutions"
- B. Patent No. 6,591,289 merely one reference showing the use of template shared over network was well known in the art.
- C. Professional's Handbook of Financial Risk Management, Lev Borodorsky, Business and Economics 2000, 832 pages; showing defining data requirements that show operational risk exposure as control points was well known, some relevant pages attached herein.
- D. Auditing systems: 5 Star at Merck Sharp and Dohme, James, Phil, (attached)

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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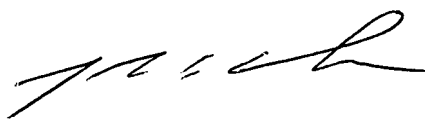
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLB
11/13/2006



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